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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MAIS, MARK A

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 11/19/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

KS

Office Action Summary

Application No.

09/593,821

Applicant(s)

KEUNG ET AL.

Examiner.

Mark A Mais

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. Applicant is reminded that the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Objections

2. The disclosure is objected to because of the following informalities: The specification contains references to copending and/or issued applications without the reference to the U.S. application/serial numbers throughout the specification (e.g., pages 18 and 22). Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Pickett (USP 6,154,465).

5. With regard to claim 1, Pickett discloses a method for operating a telecommunications system comprises: receiving a telephone call from an external telephone line (**Fig. 3, telephone call received through WAN services network 58; see also col. 18, lines 41-43**); determining a computer network address and switching data in response to the telephone call (**VoIP (col. 3, lines 9-13 and col. 13, lines 9-15) inherently sends TCP/IP packets which includes network address information, see col. 18, lines 49-52**); coupling the telecommunications system with a remote telecommunications system at the computer network address (**the VoIP call is initially addressed to the appropriate telephone number; see col. 18, lines 43-44**); transmitting switching data from the telecommunications system to the remote telecommunications system via the Internet (**transmitted via WAN for the appropriate VoIP telephone number which, inherently, sends TCP/IP packets, see col. 18, lines 49-52**); and coupling the telephone call to an auto attendant at the remote telecommunications system in response to the switching data (**fig.**

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3, the VoIP call is initially addressed to the appropriate telephone number before being forwarded to computer 24 which is running the office attendant; col. 18, lines 44-48).

6. With regard to claims 2-9, Pickett discloses receiving additional input from the external telephone line **(inherently, this would be either DTMF tones (col. 2, line 49) or voice response (col. 46, lines 44-45) for use with POTS system, or TCP/IP information for VoIP for use via T1/ATM/Wireless portions of WAN 58);** and transmitting the additional data to the remote telecommunications system **(via WAN 58);** wherein the additional data is processed by the auto attendant **(col. 18, lines 23-32; see also directory 27, col. 11, lines 40-43).**

7. With regard to claim 10, Pickett discloses a method for operating a telecommunications system comprises: receiving a telephone call from an external telephone line into the telecommunications system **(Fig. 3, telephone call received through WAN services network 58; see also col. 18, lines 41-43);** coupling the external telephone line to an auto-attendant at the telecommunications system **(fig. 3, the VoIP call is forwarded to computer 24 which is running the office attendant; col. 18, lines 44-48);** outputting a menu selection message to the external telephone line **(Fig. 3, directory information provided via WAN 58; see also col. 11, lines 40-43);** receiving input data from the external telephone line for the auto attendant via a wide area network, in response to the menu selection message **(user inherently uses the directory information to connect to the correct person);** determining a computer network address and switching data in response to the input data **(VoIP (col. 3, lines 9-13 and col. 13, lines 9-15) inherently sends TCP/IP packets which includes network address information,**

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see col. 18, lines 49-52); coupling the telecommunications system with a remote telecommunications system at the computer network address **(the VoIP call is addressed to the appropriate telephone number after accessing directory 27; see col. 11, lines 40-43)**; transmitting switching data from the telecommunications system to the remote telecommunications system; and coupling the telephone call to a telephone coupled the remote telecommunications system in response to the switching data **(the office attendant inherently provides the correct routing information from directory 27 and connects or forwards the call to the appropriate user; see also transferred to particular extension, col. 18, lines 49-52)**.

8. With regard to claims 11-20, Pickett discloses a (name) directory **(directory 27, col. 11, lines 40-43)** where a user can provide response input **(inherently, this would be either DTMF tones (col. 2, line 49) or voice response (col. 46, lines 44-45) for use with POTS system, or TCP/IP information for VoIP for use via T1/ATM/Wireless portions of WAN 58)** where the input is programmable **(inherent because controller 70 is a programmable processor)**. Moreover, the system times-out after a programmable time **(col. 19, lines 56-62)** or according to time of day **(col. 24, lines 34-35)**. Pickett further discloses that the system is controlled by host processor 70 via software **(col. 7, lines 21-43)**.

9. Claims 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Pickett (USP 6,154,465).

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10. With regard to claim 21, Pickett discloses a method for operating a telecommunications system comprises: receiving a telephone call from a telephone extension coupled to the telecommunications system (**Fig. 3, telephone call received through WAN services network 58; see also col. 18, lines 41-43**); determining a computer network address identifier and connection data in response to the telephone call (**VoIP (col. 3, lines 9-13 and col. 13, lines 9-15) inherently sends TCP/IP packets which includes network address information, see col. 18, lines 49-52**); coupling the telecommunications system with a telecommunications system at the computer network address (**the VoIP call is initially addressed to the appropriate telephone number; see col. 18, lines 43-44**); transmitting connection data from the telecommunications system to the telecommunications system at the computer network address via a computer network (**transmitted via WAN for the appropriate VoIP telephone number which, inherently, sends TCP/IP packets, see col. 18, lines 49-52**); and coupling the telephone call to an auto attendant at the telecommunications system at the computer network address in response to the connection data (**fig. 3, the VoIP call is initially addressed to the appropriate telephone number before being forwarded to computer 24 which is running the office attendant; col. 18, lines 44-48**).

11. With regard to claims 22-30, Pickett discloses a (name) directory (**directory 27, col. 11, lines 40-43**) where a user can provide response input (**inherently, this would be either DTMF tones (col. 2, line 49) or voice response (col. 46, lines 44-45) for use with POTS system, or TCP/IP information for VoIP for use via T1/ATM/Wireless portions of WAN 58**) where the input is programmable (**inherent because controller 70 is a programmable processor**).

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Moreover, the system times-out after a programmable time (**col. 19, lines 56-62**) or according to time of day (**col. 24, lines 34-35**). Furthermore, Pickett discloses a WAN (**col. 24, line 49**), LAN (**col. 13, line 44**), the internet (**col. 6, line 65**), and packetized transfers (VoIP) via TCP/IP over the internet and that the system 50 can be co-located with the telephone system (**Fig. 3**). Pickett further discloses that the system is controlled by host processor 70 via software (**col. 7, lines 21-43**).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(a) Nance et al. (USP 6,496,500) System and method for controlling telephone calls through a cross platform enabled internet browser.

(b) Pang et al. (USP 6,289,025) Systems and methods for multiple mode voice and data communication using intelligently bridged TDM and packet buses and methods for performing telephony and data functions using the same.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Mais whose telephone number is (703) 305-6959. The examiner can normally be reached on 8:00-4:30.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (703) 305-4366. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-6182.

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15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

November 7, 2003

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke extending to the right.

WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600